

### **Remarks**

Claims 1-14, 17-21 and 24-26 are pending and have been examined on the merits. Claims 18-21 and 26 are withdrawn and claims 15, 16, 22, 23 and 31-36 are canceled. Claims 1, 13 and 14 have been added. The new claims are supported, *inter alia*, at page 8, lines 30-31 of the specification and original claims 1 and 9-14.

### **Objections**

Applicants urge reconsideration of the outstanding objections to claims 1-14, 17, 24, 25, 28, 29 and 30 for the reasons explained in the concurrently filed Request for Reconsideration of a Decision on Petition. For the same reasons, applicants respectfully request rejoinder of claims 18-21 and 26. The argument of the petition is reproduced below.

### **Argument With Respect to the Chemical Compound**

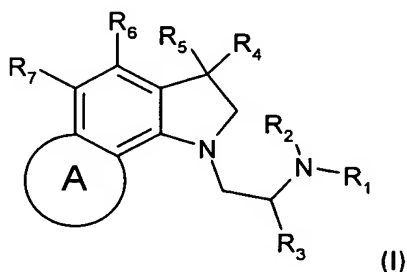
*In Response to the Decision on Petition, Applicants Have Amended the Claims to Recite That the A Ring is a 5-membered Ring*

The Decision on Petition dated August 17, 2004 states that due to the variation in the A ring being either a 5- or 6-membered ring, there is a shared chemical structure. While applicants do not agree with this proposition, they have amended the claims to a structure that the Group Director would presumably consider to have unity of invention, i.e. wherein the A ring is a 5-membered ring. Accordingly, applicants urge that under the Group Director's Decision on Petition, the present claims do have unity of invention.

Additional reasons that support applicants' position that the restriction requirement is improper are given below.

*The Restriction Requirement Arbitrarily Ignores What the Applicants Define to be Their Invention*

Claim 1 of the present invention is directed to the following core structure of formula (I):



R<sub>3</sub> is defined by the claims to be alkyl and A is a 5-membered ring optionally containing one or more heteroatoms selected from N, O or S. Thus, as part of the core structure what applicant's claim to be their invention, there is a branched 2-aminoalkyl group attached to the N of a core tricyclic indoline.

PCT Rule 13.2

Determination of unity of invention under the Patent Cooperation Treaty is governed by PCT Rule 13.2, which defines unity of invention to exist where there is technical relationship among the inventions involving one or more of the same or corresponding special technical features. As stated in Rule 13.2, reproduced below, special technical features are required by the Treaty to be treated as a whole.

§ 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art. (Emphasis added.)

Applicants contend that the outstanding restriction requirement does not view Formula (I) as a whole and is, therefore, improper. Properly viewed as a whole, it should be

recognized that Formula (I) is a tricyclic indoline-type moiety with a branched 2-aminoalkyl group attached to the N of the tricyclic indoline.

#### Administrative Instructions Under the PCT

The Administrative Instructions Under the PCT, Annex B, Part 1 at page AI-63 of the MPEP, provide further guidance as to the meaning of the “special technical feature” defined in Rule 13.2. The last sentence of paragraph (b) at page AI-63 states “[t]he determination [of special technical features] is made on the contents of the claims as interpreted in light of the description and drawings (if any).” The specification of the present application fully supports that the branched 2-aminoalkyl group attached to the N of the tricyclic indoline is a special technical feature. See Formula I at page 5 of the present specification. Claim 1 of the present application fully supports this as well.

#### Examples of the Administrative Instructions Under the PCT

Applicants also contend the decision to exclude the branched 2-aminoalkyl group as part of the special technical feature is contrary to Examples 19 and 20 of the Administrative Instructions Under the PCT at pages AI 71-72 of the MPEP. Examples 19 and 20 are considered common structures where unity of invention was found. Both structures in their totality have a heterocyclic core linked to a linear chain, both of which were considered when evaluating the unity of invention. Examples 19 and 20 are reproduced below.

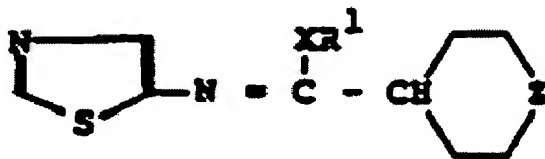
Example 19 is a compound of the formula:



wherein  $R_1$  is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene ( $-CH_2-$ ). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group -N=C-SCH<sub>3</sub> linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art. (Emphasis added.)

Example 20

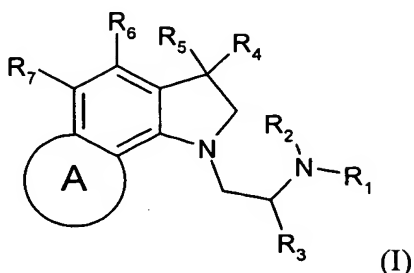


wherein R<sup>1</sup> is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S).

The compounds are useful as pharmaceuticals and contain the 1,3-thiazolyl substituent which provides greater penetrability of mammalian tissue which fact makes the compounds useful as relievers for headaches and as topical anti-inflammatory agents.

All compounds share a common chemical structure, the thiazole ring and the six atom heterocyclic compound bound to an imino group, which occupy a large portion of their structure. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art. (Emphasis added.)

In both Examples 19 and 20 of the Administrative Instructions Under the PCT, the entire chemical structure, common to all chemical compounds, was found to possess unity of invention. In the present claims, the structure common to all chemical compounds is the structure of Formula (I) as depicted below.



wherein:  $R_1$  and  $R_2$  are independently selected from hydrogen and alkyl;  $R_3$  is alkyl;  $R_4$  and  $R_5$  are selected from hydrogen and alkyl;  $R_6$  and  $R_7$  are independently selected from hydrogen, halogen, hydroxy, alkyl, aryl, amino, alkylamino, dialkylamino, alkoxy, aryloxy, alkylthio, alkylsulfoxyl, alkylsulfonyl, nitro, carbonitrile, carbo-alkoxy, carbo-aryloxy and carboxyl; and A is a 5-membered ring optionally containing one heteroatom selected from N, O or S, wherein the atoms of the ring A, other than the unsaturated carbon atoms of the phenyl ring to which the ring A is fused, are saturated or unsaturated, or a pharmaceutically acceptable salt, addition compound or prodrug thereof.

In conclusion, the decision to not consider the branched 2-aminoalkyl group along with the rest of the structure of Formula I which is common to all claims is not supportable under PCT Rule 13, the Administrative Instructions Under the PCT, and the examples under the Administrative Instructions.

*The Combination of U.S. Patent No. 5,633,276 and 5,755,829 Does Not Support a Finding of a Lack of Unity of Invention*

The Examiner first cited Formula I U.S. Patent No. 5,633,276 to support a finding of lack of unity of invention. See pages 4-5 of the Office Action dated June 6, 2003. Although the Examiner claimed to analyze the present invention as a whole, in the written Office Action, the Examiner's analysis did not take into account the invention includes a branched amino ethyl group, *i.e.* a  $(CH_2)(CHR_3)_pNR_1R_2$ . In a subsequent telephone conversation with the undersigned representative of the Applicants, the Examiner stated that the branched amino ethyl group was not part of the invention's "core" and therefore would not be considered for purposes of unity of invention.

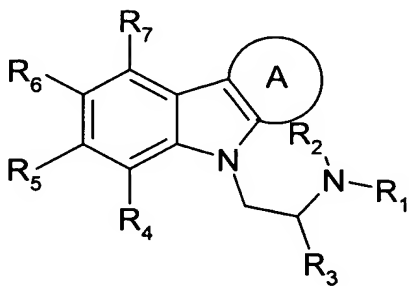
In the next Office Action, the Examiner stated that even if the  $(CH_2)(CHR_3)_pNR_1R_2$  moiety were considered to be part of the invention, there would still be no unity of invention over the structure disclosed at column 2, lines 5-51 U.S. Patent No. 5,755,829 (apparently in

combination with Formula I of U.S. Patent No. 5,633,276.) Applicants contend that the '829 patent does not cure the deficiencies of the '276 patent. The '829 patent discloses a bicyclic indoline compound that is used as a hair dye and is not described as having any pharmaceutical properties. Moreover, there is no suggestion to select the  $(\text{CH}_2)(\text{CHR}_3)_p\text{NR}_1\text{R}_2$  moiety from the vast array of possible substituents of the  $\text{R}_1$  variables disclosed at column 2, lines 14-29 of the '829 patent. In contrast to the '829 patent, the present invention is tricyclic and has a  $(\text{CH}_2)(\text{CHR}_3)_p\text{NR}_1\text{R}_2$ . None of these aspects of the present invention are taught or suggested by the '829. Due to very different structures and uses of the '829 and '276 patents, applicants contend that there would be no motivation to combine these two references to arrive at the present invention.

*The Restriction Requirement is Inconsistent With Previous Claims US Patent No. 6,706,750 Issued on March 16, 2004*

The following are copies of the claims of US Patent No. 6,706,750, which was also a nation phase application with the same assignee of the present application.

1. A chemical compound of formula (I):



(I)

wherein:

$\text{R}_1$  and  $\text{R}_2$  are independently selected from hydrogen and alkyl;

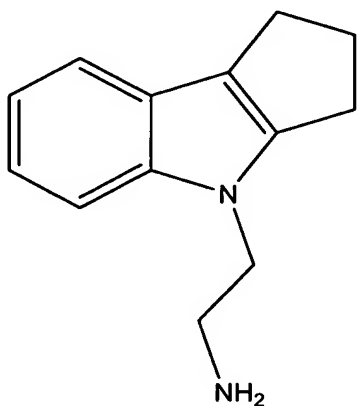
$\text{R}_3$  is alkyl;

$\text{R}_4$ ,  $\text{R}_6$  and  $\text{R}_7$  are independently selected from hydrogen, halogen, hydroxy, alkyl, aryl, amino, alkylamino, dialkylamino, alkoxy, aryloxy, alkylthio, alkylsulfoxyl, alkylsulfonyl, nitro, carbonitrile, carbo-alkoxy, carbo-aryloxy and carboxyl;

R<sub>5</sub> is selected from hydrogen, halogen, hydroxy, alkyl, aryl, amino, alkylamino, dialkylamino, alkoxy, aryloxy, alkylthio, alkylsulfoxyl, alkylsulfonyl, nitro, carbonitrile, carbo-alkoxy, carbo-aryloxy and carboxyl; and

A is a 5-membered partially unsaturated or aromatic heterocyclic ring or a 5-membered partially unsaturated carbocyclic ring, or a pharmaceutically acceptable salt, addition compound or prodrug thereof.

Although applicants are aware that facts the decision made in an issued patent is not binding precedent, it is noteworthy that in of US Patent No. 6,706,750 a prior art rejection under 35 USC § 103 was made based on the following compound:



Applicants urge that the present restriction requirement is inconsistent with the claims of US Patent No. 6,706,750 and although this patent is not binding precedent on the presently examined claims, it should be a goal of the USPTO to have consistent policies.

Argument with Respect to the Method

Applicants urge that all of the pending method claims have unity of invention because they are linked by a common structure. Moreover, the specification supports the proposition that the pending method claims have unity of invention. The Examiner has provided no evidence to the contrary. Finally, the references submitted with the July 7, 2003 response support applicants' position with respect to the unity of invention with the method of use claims. For example, the article *Curr. Opin. Invest. Drugs* by Kennet, discusses how the present invention might be useful with respect to "cognitive impairment" (pages 340-341), "migraine prophylactic properties" (page 343), or "intracranial pressure [from] mass lesions, head trauma, acute or hydrocephalus, or pseudotumor cerebi" (pages 344-345).

Therefore, the outstanding objection should be withdrawn and examination on the merits with respect to all of the pending claims is respectfully requested. Should the Examiner fail to find unity of invention with respect to claim 1, at the very least, the Office is respectfully requested to find unity of invention with respect to one or more of new claims 31-36, in particular claims 31-34, most preferably claim 31. All of these claims represent sub genera of claim 1, but allow for more variation of the A ring than the outstanding restriction requirement.

For the reasons above, applicants believe the present claims are in condition for allowance and earnestly solicit notice to this effect. The Examiner is invited to contact the undersigned representative with respect to any issues concerning this application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or



even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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